



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/574,294	05/19/2000	Stephen G. Bodurtha	0326-136A	7981
9629	7590	09/13/2005	EXAMINER	
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			ALPERT, JAMES M	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/574,294

Applicant(s)

BODURTHA ET AL.

Examiner

James Alpert

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05/04/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-50 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

HC

### **DETAILED ACTION**

The following communication is in response to Applicant's amendment filed on 05/04/2005.

#### ***Status of Claims***

The examiner acknowledges receipt of a copy of the supplemental amendment filed February 26, 2003. Applicant has demonstrated that the propriety in the status labels used in the amendments submitted on May 28, 2004. Those amendments are entered into the record, and the status of the claims is as follows: Claims 5-6 are original. Claims 9-11 & 20 are currently amended. Claims 1-4,7-8,12-19 & 21-23 are previously presented. Claims 24-50 are new.

Claims 1-50 are, therefore, currently pending.

#### ***Response to Arguments***

Please note that MPEP §811 states, in reference to restriction requirements of applicant's claims:

37 CFR 1.142(a), second sentence states: "[i]f the distinctness and independence of the invention be clear, such requirement will be made before any action upon the merits; however, it may be made at any time before final action in the case at the discretion of the examiner." This means the examiner should make a proper requirement as early as possible in the prosecution, in the first action if possible, otherwise, as soon as the need for a proper requirement develops. (underline added by examiner for emphasis)

The current Examiner has reviewed the application and claims, and observed the necessity of restriction to achieve a satisfactory examination of the application. The claims are of such distinctiveness that further prosecution without a restriction election would require additional time-consuming search and analysis, imposing a serious

Art Unit: 3624

burden on the Office. Thus, before addressing the applicant's specific arguments, provided in the remarks submitted on May 28, 2004, the following election is required.

***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

1. Claims 1-6,24-25,30,34,39 drawn to a system for managing one or more Security receipts, classified in class 711, subclass 1.
2. Claims 20-23,29,38,43 drawn to a system for managing, tracking, and implementing changes in ownership in Security Receipts, classified in class 713, subclass 1.
3. Claims 7-8,26,31,35,40, drawn to a method for creating a tradable Security Receipt, classified in class 705, subclass 36R.
4. Claims 9-11,27,32,36,41, drawn to a method for creating a tradable security vehicle, classified in class 705, subclass 36R.
5. Claims 12-19,28,33,37,42, drawn to a method of trading interests in capitalized securities, classified in class 705, subclass 37.
6. Claims 44-50, drawn to a method for trading securities, classified in class 705, subclass 37.

The inventions are distinct, each from the other because the inventions are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable and/or have separate utility. See MPEP § 806.05(d).

In the instant case, Invention 1 has separate utility that is unique, such as a computer system for storing data relating to underlying securities and the security receipts. Invention 2 has separate utility such as a network platform with plural workstations for creating security receipts. Invention 3 has separate utility such as providing a bundle of pre-existing securities. Invention 4 has separate utility such as

Art Unit: 3624

creating additional tradable security vehicles having identical characteristics at a price corresponding to underlying securities. Invention 5 has separate utility such as operating an exchange having listed securities that include one or more tradable security vehicles. Invention 6 has separate utility such as depositing shares of a plurality of companies into a trust.

Because these inventions are distinct for the reasons given above, the search for each invention would require finding references teaching various elements of the invention that are unique to each individual invention, but not to the remaining Inventions. This would require multiple searches, and thus the restriction for examination purposes as indicated is proper.

#### ***Reminders***

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicant is reminded that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that a shortened statutory period for response to this action is set to expire 30 (thirty) days from the mail date of this letter. Failure to respond within


Art Unit: 3624

the period for response will result in abandonment of the application. See 35 U.S.C 133, MPEP §'s 710.02, 710.02(b).

### ***Conclusion***

A telephone call was made to Steven Underwood, Registration #47205 on 08/31/2005, to request an oral election to the above restriction requirement, but did not result in an election being made. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Alpert whose telephone number is (571) 272-6738. The examiner can normally be reached on M-F 9:30-6:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



James M. Alpert  
31 August 2005

VINCENT MILLIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER



VINCENT MILLIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600